



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/156,334 09/18/98 NOTANI

R 020431.0463

EXAMINER

TM02/0810

BAKER & BOTTS  
2001 ROSS AVE  
DALLAS TX 75201-2980

DIXON, T

ART UNIT

PAPER NUMBER

2161  
DATE MAILED:

08/10/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/156,334

Applicant(s)

NOTANI ET AL.

Examiner

Thomas A. Dixon

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Amendment of 11 June 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10-12, 15-20 and 48 is/are pending in the application.
- 4a) Of the above claim(s) 21-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-12, 15-17 and 48 is/are rejected.
- 7) ☐ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 11.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

2. Claims 8, 9, 13 and 14 have been cancelled, claims 21-48 have been added.

IDS 9, entered 11 June 2001, has been considered.

### ***Election/Restrictions***

3. Newly submitted claims 21-47 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The newly added claims introduce the system utilizing an "intermediary computer system", rather than the "computer system" of the original claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-47 are withdrawn from consideration

Art Unit: 2161

as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Specification***

4. The objection to the disclosure is withdrawn.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7, 20, 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Flores et al (5,630,069).

As per Claim 1.

Flores et al ('069) discloses:

storing a set of predetermined functions for a work flow to be performed at a plurality of distributed nodes, see column 18, line 30 – column 19, line 12;  
automatically interacting with the workflow at each of the distributed nodes to perform the predefined functions, see column 19, lines 3-12.

As per Claim 2.

Flores et al ('069) discloses all the limitations of Claim 1.

Flores et al ('069) further discloses the set of predefined functions are operable to generate a work flow between a plurality of enterprises see figure 2 (customers and performers associated with work flows S1, S2, P1, P2, C1 and C2), and column 17, line 14 – column 18, line 28.

As per Claim 3.

Flores et al ('069) discloses all the limitations of Claim 1.

Flores et al ('069) further discloses the predefined functions are operable to transmit data associated with the operation of the workflow at each of the distributed nodes in to a monitoring system, see Column 5, lines 9-13, also column 8, lines 1-5.

As per Claim 4.

Flores et al ('069) discloses all the limitations of Claim 1.

Art Unit: 2161

Flores et al ('069) further discloses the predefined functions are operable to deploy the work flow to the distributed nodes, see Column 6, lines 9-33.

As per Claim 5.

Flores et al ('069) discloses:

receiving a preliminary collaboration from a first enterprise, see figure 1d and Column 3, lines 24-42;

automatically transmitting the preliminary collaboration to a predefined second enterprise for review, see figure 1d and Column 3, lines 24-42;

receiving a response to the preliminary collaboration from the second enterprise, see figure 1d and Column 3, lines 24-42;

automatically transmitting the response to the first enterprise for review, see figure 1d and Column 3, lines 24-42;

receiving a response to the response of the second enterprise from the first enterprise, the response of the first and second enterprises ultimately resulting in a final collaboration based on the preliminary collaboration and optimized for the first and second enterprises, see column 3, lines 33-36.

As per Claim 6.

Flores et al ('069) discloses all the limitations of claim 5.

Flores et al ('069) further discloses the response of the first enterprise comprises a comment on the preliminary collaboration, see Column 3, lines 33-36, and Column 10, lines 15-18.

As per Claim 7.

Flores et al ('069) discloses all the limitations of claim 5.

Flores et al ('069) further discloses the response of first enterprise comprises a modification of the preliminary collaboration, see Column 3, lines 33-36, and Column 10, lines 15-18.

As per Claim 20.

Flores et al ('069) discloses:

receiving a first predefined set of data associated with operation of a first portion of the collaboration at a first node of a first enterprise, the first set of data having been collected in response to an automatic query of the first node for the first set of data, see column 4, lines 22-64 and column 8, lines 26-34;

automatically transmitting the first set of data from the computer-implemented process to a monitoring system in response to the query of the first node, see column 4, lines 58-64;

receiving a second predefined set of data associated with operation of a second portion of the collaboration at a second node of a second enterprise, the second set of data having been collected in response to an automatic query of the second node for the second set of data, see column 4, lines 22-64 and column 8, lines 26-34; and

Art Unit: 2161

automatically transmitting the second set of data from the computer-implemented process to the monitoring system in response to the querying of the second node, see column 4, lines 58-64.

As per Claim 48.

Flores et al ('069) discloses:

means for receiving a preliminary collaboration from a first enterprise, see figures 1a-f (customer, performer and arrows of communication around the conditions of satisfaction) and column 3, lines 24-43;

means for automatically transmitting the preliminary collaboration to a predefined second enterprise for review see figures 1a-f (customer, performer and arrows of communication around the conditions of satisfaction) and column 3, lines 24-43;

means for receiving a response from the preliminary collaboration from the second enterprise see figures 1a-f (customer, performer and arrows of communication around the conditions of satisfaction) and column 3, lines 24-43;

means for automatically transmitting the response of the second enterprise to the first enterprise for review see figures 1a-f (customer, performer and arrows of communication around the conditions of satisfaction) and column 3, lines 24-43; and

means for receiving a response to the response of the second enterprise from the first enterprise, the responses of the first and second enterprises ultimately resulting in a final collaboration based on the preliminary collaboration and optimized for the first and second enterprises, see column 3, lines 24-43.

automatically querying a first node if a first enterprise for a first predefined set of data associated with the operation of a collaboration at a first node, see figures 1a-f (customer, performer and arrows of communication around the conditions of satisfaction);

transmitting the first set of data to a monitoring system, see figures 1d (observer) and Column 8, lines 1-5;

automatically querying a second node of a second node for a predefined second set of data associated with an operation of the collaboration at the second node, see figures 1a-f (customer, performer and arrows of communication around the conditions of satisfaction); and

transmitting the second set of data to the monitoring system, see figures 1d (observer) and Column 8, lines 1-5.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2161

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-12, 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flores et al (5,630,069) in view of Fox et al.

As per Claim 10.

Flores et al ('069) discloses all the limitations of claim 5.

Flores et al ('069) further discloses:

receiving an approval from each of the first and second enterprises for a collaboration based on the preliminary collaboration and reflecting the responses of the first and second enterprises, see Column 3, lines 30-36;

subsequent to receiving the approvals from the first and second enterprises, automatically transmitting the collaboration to a predetermined third enterprise for review, see Column 6, lines 33-37;

Flores et al ('069) discloses customers and suppliers who communicate bi-directionally, and an observer, who has the ability to see the collaborations, but does not disclose that the third party acts in the communication.

Art Unit: 2161

Fox et al teaches a conductor that orchestrates the behavior or other supply chain agents, an observer who also acts and communicates bi-directionally, see page 3, lines 1-23 for the benefit of overall quality of supply chain management.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Flores et al ('069) to include an observer with the ability to act and communicate bi-directionally, as the other agents do, for the benefit of overall quality of supply chain management.

As per Claim 11.

Flores et al ('069) in view of Fox et al discloses all the limitations of claim 10.

Flores et al ('069) discloses comments on the collaboration, see Column 3, lines 33-36, and Column 10, lines 15-18, but does not specifically disclose the response of the third enterprise comprises a comment on the collaboration

Fox et al teaches a conductor that orchestrates the behavior or other supply chain agents, an observer who also acts and communicates bi-directionally, see page 3, lines 1-23 for the benefit of overall quality of supply chain management.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Flores et al ('069) to include an observer with the ability to act and communicate bi-directionally, as the other agents do, for the benefit of overall quality of supply chain management.

As per Claim 12.

Flores et al ('069) in view of Fox et al discloses all the limitations of claim 10.

Flores et al ('069) discloses modifications of the collaborations, see Column 3, lines 33-36, and Column 10, lines 15-18, but does not specifically disclose the response of the third enterprise comprises a modification of the collaboration.

Fox et al teaches a conductor that orchestrates the behavior or other supply chain agents, an observer who also acts and communicates bi-directionally, see page 3, lines 1-23 for the benefit of overall quality of supply chain management.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Flores et al ('069) to include an observer with the ability to act and communicate bi-directionally, as the other agents do, for the benefit of overall quality of supply chain management.

As per Claim 15.

Flores et al ('069) discloses:

receiving a final collaboration approved by first and second enterprises, see figures 1a-f (customer, performer and arrows of communication around the conditions of satisfaction), and

Column 3, lines 24-42, and Column 7, line 10 – Column 8, line 57;

automatically transmitting a predetermined first part of the collaboration to a predetermined second enterprise, see figures 1a-f (customer and performer), and column 3, lines 27-29, and



Art Unit: 2161

automatically transmitting a predetermined second part of the collaboration to a predetermined third enterprise, see figures 1d (observer) and Column 8, lines 1-5.

Flores et al ('069) does not specifically disclose the third enterprise has input to the collaboration.

Fox et al teaches a conductor that orchestrates the behavior or other supply chain agents, an observer who also acts and communicates bi-directionally, see page 3, lines 1-23 for the benefit of overall quality of supply chain management.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the abilities of the observer of Flores et al ('069) to include a third party, such as the observer, with the ability to act and communicate bi-directionally, as the other agents do, for the benefit of overall quality of supply chain management.

As per Claim 16.

Flores et al ('069) in view of Fox et al discloses all the limitations of claim 15.

Flores et al ('069) further discloses the requesting an approval from the second enterprise for operation of the first part of the collaboration, modification is amendment to the preliminary collaboration, see Column 3, lines 33-36, and Column 10, lines 15-18.

Flores et al ('069) does not disclose requesting an approval from the third enterprise for operation of the second part of the collaboration at a node of the third enterprise.

Fox et al teaches a conductor that orchestrates the behavior or other supply chain agents, an observer who also acts and communicates bi-directionally, see page 3, lines 1-23 for the benefit of overall quality of supply chain management.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify the invention of Flores et al ('069) to include an observer with the ability to act and communicate bi-directionally, as the other agents do, for the benefit of overall quality of supply chain management.

As per Claim 17.

Flores et al ('069) discloses all the limitations of claim 16.

Flores et al ('069) further discloses the in response to the approval from the second enterprise, notifying the third enterprise of the approval, see Column 8, lines 1-5.

### ***Response to Arguments***

Applicant's arguments filed 11 June 2001 have been fully considered but they are not persuasive.

Applicant's arguments that Flores ('069) does not disclose predefined functions is incorrect, the workflow generating and linking functions are predefined, and are not

Art Unit: 2161

limited to intra-enterprise workflows, as can be seen by the use of the words customer and performer, which in a business environment suggest a multi-enterprise interaction.

Applicant's arguments that Flores ('069) does not disclose automatic transmission of responses is likewise incorrect, the predefined linking functions contain triggers which are automatic actions which are taken at workflow initiation, workflow activation, workflow acts, states or conditions of the conditional links.

***Additional Prior Art***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WO98/08177 is the closest foreign art, but does not disclose all the limitations of the claims.

Fox is the closest non-patent literature, but does not disclose all the limitations of the claims.

***Allowable Subject Matter***

9. Claims 18, 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Art Unit: 2161

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Friday 7 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

TAD   
August 8, 2001

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100